

Response to Restriction Requirement  
Application No. 10/658,372

**REMARKS**

The Examiner requests that Applicants select one of the following groups for prosecution on the merits:

Group I - Claims 1-5 and 8-10, drawn to methods of making a first product reflection mask blank by forming a multilayer reflection film on a substrate, heat treating the multilayer reflection film, and then forming an absorber layer on the multilayer reflection film, classified in class 204, subclass 192.11.

Group II - Claims 6 and 11, drawn to methods of patterning the absorber layer on a reflection mask blank to make a second product patterned reflection mask, classified in class 430, subclass 5.

Group III - Claims 7 and 12, drawn to methods of patterning a semiconductor substrate using a second product patterned reflection mask, classified in class 430, subclass 311.

In response to the Restriction Requirement Applicant has elected group I (claims 1-5 and 8-10) in the above-identified application for examination.

The election is made with traverse. However, application reserves all rights under 35 U.S.C. § 121 to file a divisional application to the non-elected groups of claims.

Turning next to the basis of traversal, Applicant notes that Group I includes independent claims 1 and 8, which are drawn to methods of making a first product reflection mask blank by forming a multilayer reflection film on a substrate, heat treating the multilayer reflection film, and then forming an absorber layer on the multilayer reflection film, classified in class 204, subclass 192.11.

The second group includes claims 6 and 11 and is drawn to a method of making a patterned reflection mask, classified in class 430, subclass 5, although use is made of the blank of claims 1 and 8.

The third group includes claims 7 and 12 and is drawn to methods of patterning a semiconductor substrate using a second product patterned reflection mask, classified in class

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430, subclass 311, although use is made of the blank of claims 1 and 8 and the mask of claims 7 and 12.

While different in scope, there is a commonality to the underlying processes in all three groups, namely, the steps to produce the reflection mask blank of claims 1 and 8. Thus, the claims of group I may be viewed as subcombination claims and the claims of groups II and III may be viewed as combination claims.

According to USPTO regulations, as embodied in MPEP 803, a restriction is proper only if (1) they are able to support separate patents and (2) they are EITHER independent (MPEP 802.01, 806.06 and 808.01) OR distinct (MPEP 806.05). Satisfaction of the independent or distinct criteria is enough to support a restriction, regardless of whether the searches overlap.

As to the requirement for independent under criteria (2), MPEP 802.01 (I) states that there is independence where there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation and effect. An example of independence is a process and an apparatus incapable of being used in practicing the process. Applicant would submit that the three groups of claims are not independent since they all depend from group I, though they are directed to different products.

As to the requirement for distinct under criteria (2), MPEP 802.01 (II) states that there is distinctness where the two or more inventions are (a) related and (b) if the inventions as claimed are not connected in at least one of design, operation or effect, e.g., can be used in a materially different process and (c) wherein at least one invention is patentable (novel and non-obvious over the other). MPEP 806.05(c) is referenced for a combination/subcombination example.

The requirement (c) is that the combination as claimed does not require the particulars of the subcombination as claimed for patentability and the subcombination has utility by itself. The requirement may be understood as stating that the subcombination is not essential to the combination. Applicant submits that, in the present case, the combination claims of group III require the subcombination of group I alone or combined with group II. Similarly, the

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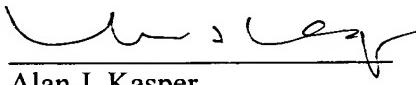
combination claims of group II require the subcombination of group I for patentability. Applicant respectfully submits that the claims are not distinct.

Since the claims are neither independent nor distinct, Applicant submits that the traversal is proper and that the restriction should be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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